

REMARKS

In the Office Action, the Examiner rejected claims 1-30. By the present Response, Applicants have amended claims 1-9, 18, and 23. No claims are presently added or canceled. These amendments do not add any new matter. Upon entry of these amendments, claims 1-30 will remain pending in the present application and are believed to be in condition for allowance. In view of the foregoing amendments and the following remarks, Applicants respectfully request reconsideration and allowance of all pending claims.

Claim Rejection under 35 U.S.C. § 101

The Examiner rejected claims 1-30 under 35 U.S.C. § 101, because the claimed invention is directed to non-statutory subject matter. In particular, the Examiner stated that:

A 35 U.S.C. 101 must be tied to another statutory class such as a physical apparatus or provide a physical transformation. The claimed methods are not tied to another statutory class or do not provide a physical transformation. Regarding claims 1 and 23, the steps of providing information and receiving information do not require another statutory class or do not provide a physical transformation. Regarding claims 9 and 18, the steps of providing information and processing information do not require another statutory class or do not provide a physical transformation.

Office Action, page 2.

The Applicant respectfully traverses this rejection. According to the Supreme Court, congress intended statutory subject matter to “include anything under the sun that is made by man.” *Diamond v. Chakrabarty*, 447 U.S. 303, 308-09; 206 U.S.P.Q. 193, 197 (1980). Indeed, exclusions of statutory subject matter are limited to laws of nature, natural phenomena and abstract ideas. *See Diamond v. Diehr*, 450 U.S. 175, 185; 209 U.S.P.Q. 1, 7 (1981). Other than these specific exceptions, therefore, nearly anything man made is statutorily patentable subject matter under 35 U.S.C. § 101. In determining when process or

method claims include statutory subject matter, the Supreme Court in *Diehr* stated that “[t]ransformation and reduction of an article ‘to a different state or thing’ is the clue to the patentability of a process claim that does not include particular machines.” *See id.* 450 U.S. at 183-185, 209 U.S.P.Q. at 6. The *en banc* court in *Bilski* held that “the machine-or-transformation test, properly applied, is the governing test for determining patent eligibility of a process under § 101.” *Bilski*, No. 2007-1130, ___F.3d___, 2008 WL 4757110, *9 (Fed. Cir. Oct. 30, 2008)(*en banc*). With regard to the machine-or-transformation test, the Federal Circuit explained that “[a] claimed process is surely patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing.” *Id.* at *5 (citations omitted).

While the Applicant does not necessarily agree with the Examiner’s rejection under 35 U.S.C. § 101, in order to further prosecution, the Applicant presently amends claims 1-9, 18, and 23 to clearly tie the recited methods to another statutory class. Specifically, for example, independent claims 1, 9, 18, and 23 have each been amended to recite the physical structure of an anonymizing network along with other physical features that cooperate to perform the recited method. Thus, based on the present amendments, the Applicant asserts that claims 1, 9, 18, and 23, and the claims depending therefrom are sufficiently tied to a physical apparatus to meet the first prong of the machine-or-transformation test, which is sufficient to overcome the Examiner’s rejection under 35 U.S.C. § 101.

In view of the arguments and amendments set forth above, the Applicant requests that the Examiner withdraw the rejection under 35 U.S.C. § 101. Further, the Applicant requests that the Examiner provide an indication of allowance for independent claims 1, 9, 18, and 23, and the claims depending therefrom.

Claim Rejections Under 35 U.S.C. § 103(a)

In the Office Action, the Examiner rejected claims 1-3 and 23-25 under 35 U.S.C. § 103(a) as being unpatentable over the Sakamaki et al. (U.S. Patent No. 6,658,410) (hereafter referred to as the “Sakamaki reference”); claims 4-5 and 26-27 over the Sakamaki reference and Labrou (U.S. Publication 2004/0030894) (hereafter referred to as the “Labrou reference”), in view of Munro (U.S. Publication No. 2004/0002914) (hereafter referred to as “the Munro reference”); and, claims 6-8 and 28-30 as being unpatentable over the Sakamaki reference, in view of the Labrou reference. Applicants respectfully traverse these rejections.

Specifically, the Examiner stated the following:

9. As per claim 1, Sakamaki teaches substantially the invention as claimed including a method of exchanging information between at least one party and a plurality of intermediaries, the plurality of intermediaries including a selected intermediary, the method comprising:

providing correct information to the selected intermediary (col. 7, lines 47-57. Provide name and profile information.);

receiving modified information based on the correct information from the selected intermediary(col. 10, lines 34-45. Provide a page in response.).

10. Sakamaki does not explicitly teach of providing incorrect information to each of the plurality of intermediaries who are not the selected intermediary; receiving modified information based on the incorrect information from each of the plurality of intermediaries who are not the selected intermediary; and wherein the plurality of intermediaries do not know which of the plurality of intermediaries is the selected intermediary.

11. However, other types of intermediaries such as other matching providers and email providers are well known and accessible to a user in the art. It would have been obvious to one of ordinary skill in the art that a user may also provide incorrect information by providing false information such as interest or name or enter a wrong information to the other intermediaries, intentionally or out of error, i.e. typographical

mistake, and thus result in the other intermediaries providing information in response to the incorrect information. Furthermore, another intermediary would not know whether correct information is being submitted at another intermediary as information is maintained in privacy and would be unaware of which services the user is registered with.

12. As per claim 23, Sakamaki teaches substantially the invention as claimed including a method of exchanging information between at least one party and an intermediary, the method comprising:

a party providing a set of information to the intermediary, wherein the set of information includes a set of correct information (col. 7, lines 47-57. Provide name and profile information.);

a party receiving modified information from the intermediary, wherein the modified information includes modified information based on the correct information (col. 10, lines 34-45. Provide a page in response.).

13. Sakamaki does not explicitly teach of providing a set of incorrect information that is plausible; and a party receiving modified information based on the incorrect information; and wherein the intermediary does not know which of the least two sets of information is the correct information and does not know which of the at least two sets of modified information is based on the correct information.

14. However, it would have been obvious to one of ordinary skill in the art that a user may also provide a set of incorrect information by providing false information such as interest or name or enter a wrong age/gender or unintentionally entering incorrect information and thus result in the intermediary providing information based on the incorrect information. Furthermore, since information such as interest is a determined by a user, the intermediary would not be able distinguish which information is correct or incorrect.

Office Action, pages 3-4.

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (B.P.A.I. 1979). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). However, it is not enough to show that all the elements exist in the prior art since a claimed invention composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). It is important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. *Id.* Specifically, there must be some articulated reasoning with a rational underpinning to support a conclusion of obviousness; a conclusory statement will not suffice. *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). Indeed, the factual inquiry determining whether to combine references must be thorough and searching, and it must be based on *objective evidence of record*. See *In re Lee*, 61 U.S.P.Q.2d 1430, 1436 (Fed. Cir. 2002).

Present embodiments are directed to combining information from one or more parties through an intermediary using an anonymizing network without facilitating access to the information (e.g., proprietary data and/or a proprietary program) held by each party. See, e.g., Application, paragraphs 11-21. For example, a first party may own a proprietary program for analyzing data and a second party may own proprietary research data. *Id.* In such an example, the second party may wish to have the data analyzed by the first party's program but may be concerned about allowing the first party to access their proprietary data, thus, one or more intermediaries may be used to analyze the data with the proprietary program. *Id.* However, in such an example, because the parties may be concerned about providing their respective information to the intermediary or intermediaries, false (but plausible) information may also be supplied such that the intermediary or intermediaries would not be able to discern which set of data or which program is valid. *Id.*

Accordingly, as amended, independent claim 1 recites, *inter alia*, “receiving modified correct information ... via the anonymizing network, wherein the selected intermediary *interpreted the correct electronic data to yield the modified correct information with a data analysis program*; receiving modified incorrect information ... wherein each of the plurality of intermediaries ... *interpreted the incorrect electronic data to yield the modified incorrect information with one of a plurality of analysis programs*; and wherein the anonymizing network functions such that the plurality of intermediaries do not know which of the plurality of intermediaries is the selected intermediary.” (Emphasis added). Amended claim 23 recites, *inter alia*, “the party receiving at least two sets of modified information from the intermediary *using the data exchange algorithm in conjunction with the anonymizing network*, wherein the at least two sets of modified information include modified information *resulting from running a data analysis program* on the correct information and on the incorrect information; and wherein *the anonymizing network functions such that the intermediary does not know which of the at least two sets of information is the correct information and does not know which of the at least two sets of modified information is based on the correct information.*” (Emphasis added).

In contrast, the Sakamaki reference is merely directed to a user that “registers his/her personal information (name, password, profile information, etc.) J1 and search option (gender, age, interest, etc.) J2” and “his/her profile information (online ID, gender, age, location, interest, comments) J3 and the user’s image data (picture or drawing) 34” with a single service center T1, which includes a database server T2 and a web server T3. Sakamaki et al., col. 7, lines 48-55. The web server T3 prepares web pages including registered open profile information and the user’s images, and opens the web pages on the internet. *Id.* col. 7, lines 55-57.

Thus, the Sakamaki reference clearly does not include exchanging correct and incorrect information via an anonymizing network such that misappropriation of the information is avoided, as recited in claims 1 and 23. Further, the Sakamaki reference

certainly does not teach exchanging information using a data exchange algorithm in conjunction with the anonymizing network. To the contrary, the Sakamaki reference actually teaches that valid information is disclosed to the service center, and then the service center includes the valid information on the internet. This clearly would not avoid misappropriation. Further, the Sakamaki reference does not disclose providing correct information to a selected intermediary and incorrect information to other intermediaries. Rather, the Sakamaki reference merely discloses providing *all* of the information to a single entity (i.e., the service center T1). The Examiner argued that it would have been obvious to provide incorrect information to a plurality of intermediaries that are not selected. However, such an action would not function to avoid misappropriation of information. Additionally, the Sakamaki reference certainly does not disclose that a selected or non-selected intermediary interprets correct or incorrect electronic data to yield modified information *with a data analysis program*, as recited in claims 1 and 23. Rather, the Sakamaki reference merely discloses providing the information on a web page.

In view of the amendments and arguments set forth above, the Applicant asserts that independent claims 1 and 23 are allowable over the cited references. The Applicant asserts that the Sakamaki reference fails to disclose all of the recited features of claims 1 and 23, and that the deficiencies of the Sakamaki reference are not addressed by the Examiner's arguments regarding obviousness. Accordingly, the Applicant requests that the Examiner withdraw the rejection of claims 1 and 23 under 35 U.S.C. § 103 and provide an indication of allowance. Further, the Applicant requests that the Examiner withdraw the rejection of the claims depending from claims 1 and 23 under 35 U.S.C. § 103, and provide an indication of allowance. Indeed, all of the remaining rejections under 35 U.S.C. § 103 rely on the rejection of claim 1 and 23 based on the Sakmaki reference. In view of the deficiencies set forth above, the Applicant stresses that the claims depending from claims 1 and 23 are in condition for allowance, in part, because they each depend from an allowable base claim.

Payment of Fees and General Authorization for Extensions of Time

No fees are believed to be due at this time. If any additional fees, including fees for extensions of time and other reasons, are deemed necessary to advance prosecution of the present application, at this or any other time, Applicants hereby authorize the Commissioner to charge such requisite fees to Deposit Account No. 08-2025; Order No. 200308584-1 (NUHP:0233/FLE/POW). In accordance with 37 C.F.R. § 1.136, Applicants hereby provide a general authorization to treat this and any future reply requiring an extension of time as incorporating a request thereof.

Conclusion

In view of the remarks and amendments set forth above, Applicants respectfully request allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

Date: March 11, 2009

/W. Allen Powell/
W. Allen Powell
Reg. No. 56,743
(281) 970-4545

CORRESPONDENCE ADDRESS:
HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P. O. Box 272400
Fort Collins, Colorado 80527-2400